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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,894	09/23/2003	Robert M. Soule III	283-392.12	2236
20874 7590 06/22/2007 MARJAMA & BILINSKI LLP 250 SOUTH CLINTON STREET SUITE 300 SYRACUSE, NY 13202			EXAMINER LE, UYEN CHAUN	
			ART UNIT 2876	PAPER NUMBER
			MAIL DATE 06/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/669,894	SOULE ET AL	
	Examiner	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18,47-54 and 69-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 69-76,92 and 93 is/are allowed.
- 6) ☒ Claim(s) 13-18,47-54,77-91 and 94-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/31/06; 11/08/06; 04/11/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 03/14/2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Knowles et al (US 5869819 A).

Re claim 13: Knowles et al discloses a symbol generator including: a graphical user interface (col. 13, lines 23-25) including a first data input area facilitating entry of a designator for a formatted file (i.e., Block A: where www information resources serves as a formatted file)(fig. 7A; col. 15, lines 6-10), and a second data input area facilitating entry of command data (i.e., Block D: where the command data is to generate an URL-encoded barcode symbol); an encoder encoding into at least one symbol a formatted file in accordance with the designator, and a command in accordance with the input command data (fig. 7A; col. 15, line 62 through col. 16, line 7).

4. Claims 13-14, 17-18, 86-90, and 95-96 are rejected under 35 U.S.C. 102(b) as being anticipated by Antognini et al (US 6176427 B1).

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Re claims 13-14, 17-18, 86-90, and 95-96: Antognini et al discloses a symbol generator including: a graphical user interface including a first data input area facilitating entry of a designator for a formatted file (i.e., step 202: where a file is being selected) (fig. 2; col. 11, lines 20+), and a second data input area facilitating entry of command data (i.e., step 201: where the command data is to print/encode in a specific parameter) (fig. 2; col. 9, line 50 through col. 11, line 19); an encoder (i.e., formatting process 205) encoding into at least one symbol a formatted file in accordance with the designator (i.e., spot coding symbol), and a command in accordance with the input command data (fig. 2; col. 12, lines 53+); wherein the graphical user interface further includes a data input area facilitating input of path data designating a storage location for storing a formatted file onto a portable device (i.e., located in the computer hard disk or from other sources) (fig. 2; col. 11, lines 20-30); wherein the graphical user interface further includes a data input area facilitating entry of data indicating whether encoded symbol data is to be compressed (i.e., step 203) (fig. 2; col. 11, line 32 through col. 12, line 53); wherein the graphical user interface further includes a data entry area facilitating entry of data indicating whether encoded symbol data is to be encrypted prior to being encoded into a symbol (fig. 20; col. 43, line 40 through col. 44, line 38); wherein the plurality of viewable files available for encoding are stored at a memory location of a computer that presents the graphical user interface, wherein the encoder encodes a document file, wherein the encoder encodes an image file (fig. 1; col. 9, lines 30-45); wherein the symbol generator is configured so that there can be designated in the first data input area a designator for a directory stored file (i.e., computer file; it is inherently that a computer file is only retrievable with a correct destination directory designation a storage location) (col. 11, lines 20+).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 15-16, 47-54 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antognini et al in view of Hashimoto et al (US 6902114 B2). The teachings of Antognini et al have been discussed above.

Re claims 15-16, 47-54 and 91: Antognini et al has been discussed above and further discloses a step 201 for selecting a specific parameter for encoding (fig. 2), but is silent with respect to automatically changes a number of symbols to encode; indicate a number of symbols to be encoded; encoding a set of barcodes, a field indicating a total number of symbols of the set, respectively.

Hashimoto et al teaches an encode method and system where the user specifies all setup value; the capacity of the inputted data is greater than the predetermined number, the data is encoded into more than one barcode; wherein each of the encoded barcode includes a total number of barcodes making up the setting group and a serial number indicating the order of the barcode in the barcodes making up the setting group (figs. 4-7; col. 8, line 1 through col. 10, line 41); the user indicating number of symbols to be encoded and number of bytes of data into a to-be encoded barcode by setting specific parameters (fig. 5; col. 8, lines 35+), and whether a viewable field designated for encoding will be displayed at the time when a symbol encoding the viewable file is read (figs. 6-7; col. 9, line 53 through col. 10, line 41).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hashimoto et al into the system as taught by Antognini et al for intended use (i.e., encoding data into barcode symbols). Furthermore, such modification would provide a more accurate system wherein the formatted file/data is encoded into a plurality of barcodes with a proper barcode length, preventing errors of over load bar coding capacity (e.g., one barcode symbol contains a large file of information).

8. Claims 77-85 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antognini et al in view of Barile et al (US 5837986 A). The teachings of Antognini et al have been discussed above.

Re claims 77-85 and 94: Antognini et al has been discussed above, but is silent with respect to encoding into the symbol a command which when run by a reader that reads the symbol causes the reader to execute one of a plurality of file opening programs.

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Barile et al teaches the reader 3 is programmed/reprogrammed by reading barcode 14 (figs. 1 & 2; col. 8, lines 30+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Barile et al into the system as taught by Antognini et al in order to provide Antognini et al with a more versatile system which can be used to reprogram the reader instantaneously and accurately upon scanning the barcode. Furthermore, such modification would have been an obvious engineering variation, well within the ordinary skill in the art, for intended use due to the fact that a barcode can be encoded with any type of information/data, and therefore an obvious expedient.

Allowable Subject Matter

9. Claims 69-76 and 92-93 are allowed.
10. The following is an examiner's statement of reasons for allowance:

The prior art of records to Knowles, Antognini, Hashimoto, Barile and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific structure or the method a symbol generator comprising, among other things, the second input area enabling a user to designate whether a file designated for encoding in said first data input area will be displayed at the time when a symbol encoding the file is read as set forth in the claimed combination.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

11. Applicant's arguments filed 03/14/2007 have been fully considered but they are not persuasive.

12. In response to the Applicant's argument with respect to "... the Examiner has not established that Knowles teaches the element of "a data input area facilitating entry of a designator for a formatted file" in combination with an "encoder for encoding into at least one symbol a formatted file in accordance with the designator" as recited in the combination of claim 13..." (p. 10, 2nd paragraph), the Examiner respectfully disagrees and requests the Applicant to further review Knowles where box A of fig. 7A designate an input area for inputting an information resource, which serves as a formatted file, and an encoder for encoding into at least one symbol 38B a formatted file/an information resource in accordance with the designator (fig. 8). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Knowles meets the claimed invention (see the rejection above).

13. In response to the Applicant's argument with respect to Antognini does not disclose the limitation of claim 13 (p. 11, 2nd paragraph through 4th paragraph), the Examiner respectfully disagrees and requests the Applicant to further review Antognini wherein spot data (figs. 8-15) serves as a coding symbol that is generated by encoding a formatted/computer file selected in step 202 (fig. 2) in accordance with the designator (i.e., in accordance with the setting/selected parameter, for example, cell/symbol height, cell/symbol width, etc.) selected in step 201 (fig. 2).

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Accordingly, the claimed limitation, given the broadest reasonable interpretation, Antognini meets the claimed invention (see the rejection above).

14. In response to the Applicant's argument with respect to improper omnibus rejection (p. 11, 5th paragraph through p. 12, last paragraph), the Examiner respectfully submits that the rejection of claims 15-16 and 47-52 has been modified in accordance with Applicant's request for clarification, no new ground of rejection was made (see the rejection above).

15. In response to the Applicant's argument with respect to the combination of Antognini in view of Hashimoto does not teach "a data input area receiving information pertaining to a number of bar codes to encode" (page 13), the Examiner respectfully disagrees and requests the Applicant to further review Hashimoto wherein in accordance with the setup value inputted by a user at step S1 (fig. 4), a number of barcodes to be encoded is determined (step S8 and step S8a) in subsequence to checking the barcode length (step S 7) during processing (fig. 5). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Antognini in view of Hashimoto meets the claimed invention with respect to a data input area receiving information pertaining to a number of bar codes to encode (see the rejection above).

16. In response to the Applicant's argument with respect to the Examiner fails to establish "destination directory designating a storage location for data produced by decoding of symbol encoded by said symbol generator" of claim 52 (p. 14, 1st paragraph), the Examiner respectfully disagrees and requests the Applicant to further review Antognini wherein a computer file being selected in step 202 (fig. 2; col. 11, lines 20+). It is inherently that a computer file cannot be retrieved unless a specific destination directory designation a storage location is provide/indicated. Accordingly, the claimed limitation, given the broadest reasonable

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interpretation, Antognini in view of Hashimoto meets the claimed invention (see the rejection above).

17. In response to the Applicant's argument with respect to the Examiner fails to establish "encoding into said at least one symbol a command which when run by a reader that reads said at least one symbol causes said reader to execute one of a plurality of file opening programs" of claim 77 (p. 16, last paragraph), the Examiner respectfully disagrees and requests the Applicant to further review the primary reference to Antognini discloses a system and method for encoding a computer file into a spot coding symbol (see figs. 2-8). Antognini is silent with respect to the computer file/coding symbol is a command symbol that run by a reader that reads the symbol causes the reader to execute one of plurality of programs. The secondary to Barile teaches barcode 14 is a command barcode that causes the reader 3 to execute one of plurality programs (e.g., updating the reader's software program) (figs. 1-2; col. 8, lines 35-47 and lines 55-59).

18. In response to the Applicant's argument with respect to the Examiner fails to establish "symbol generator further being configured so that a designator for a configuration file including user preference configuration data can be designated in said information entry area in combination with an encoder encoding into at least one symbol said configuration file" of claim 86 (p. 18, 1st paragraph), the Examiner respectfully disagrees and requests the Applicant to further review Antognini wherein a configuration file including user preference configuration data is listed in step 201 of fig. 2 (e.g., data segments, data sectors, marker width and height, etc.) being selected to be encoded into a spot symbol (figs. 3-15). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Antognini meets the claimed invention (see the rejection above).

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on M-F 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Uyen-Chau N. Le
Primary Examiner
Art Unit 2876

June 10, 2007